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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 10/675,459  | 09/30/2003  | Richard L. Mueller JR. | ACU-128             | 5616             |
| 7590  | 03/31/2006  |                        | EXAMINER            |                  |
| OLSON & HIERL, LTD.<br>36th Floor<br>20 North Wacker Drive<br>Chicago, IL 60606 |             |                        | ROGERS, KRISTIN D   |                  |
|   |             |                        | ART UNIT            | PAPER NUMBER     |
|   |             |                        | 3736                |                  |

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                   |                     |
|------------------------------|-------------------|---------------------|
| <b>Office Action Summary</b> | Application No.   | Applicant(s)        |
|                              | 10/675,459        | MUELLER, RICHARD L. |
|                              | Examiner          | Art Unit            |
|                              | Kristin D. Rogers | 3736                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 March 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 2-9, 11-22, 24-31, 33-44, 46-53 and 55-66 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 10, 23, 32, 45 and 54 is/are rejected.
- 7) Claim(s) 1 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. The Examiner acknowledges the Applicant's election of claims drawn to Species I, of Group A, without traverse. Claims 2-9, 11-22, 24-31, 33-44, 46-53, and 55-66 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species.

***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. The use of the trademark "Mammotome" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Objections***

4. Claim 1 is objected to because of the following informalities: the work "though" should be changed to read "through". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,10,23,32,45, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Corvi et al. (20020038097). Corvi et al. shows a biopsy device for collecting a tissue sample comprising an introducer having a working end portion which includes an introducer 12 and cutter portion 18; hollow tubular sheath 12 having proximal and distal ends 14 and 16 respectively, the introducer having a side aperture 42 or 204 (page 3, paragraph 31), a cutter assembly 18 comprising a hollow cylindrical tube (page 3 paragraph 32) with diameter sized to fit inside of introducer, introducer having cutting edge 20 and cutting tube having cutting edge 22 at distal end; the endoscope assembly 264 is situated within cutter assembly (best shown in Figure 15) comprises a fiber optic bundle received within cutter tube. The cutter tube and the introducer sheath cooperate to sever the tissue sample via actuator rod 37 (page 3 paragraph 30).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristin D. Rogers whose telephone number is 571.272.7293. The examiner can normally be reached on Monday through Friday 8:00am - 4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571.272.4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KDR

  
MAX HINDENBURG  
PATENT EXAMINER  
USPTO - 3736